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EXAMINER

PLUCINSKI, JAMISUE A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 09/973,082 | Applicant(s) BJERRE ET AL. | |
| | Examiner JAMISUE A. PLUCINSKI | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,13-16 and 52-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,13-16 and 52-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5, 8, 13-16, 52-58, 60, 61, 63, 65, 68, 69, 71 and 73-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Borgeson et al (US 2003/0236739).

3. With respect to Claims 1, 13, 68, and 69: Borgeson discloses the use of a common carrier system comprising:

- a. A plurality of entities registered with the system, each having a computer storage (see abstract, Figure 4A Step 9);
- b. A server at a second entity that receives information from the entities (100) and provides a user interface (Figure 2, with corresponding detailed description) which allows a user to:
 - i. Create an electronic booking request (Figure 4A, Steps 1-3 and 17) which includes container information, transportation information and carrier information (See Steps 3-6, Figure 4A).
 - ii. Submit the electronic booking request to the server which then sends the request to a plurality of carriers (Steps 6-9, Figure 4A); and

- iii. The requests include origin and destination information; therefore the examiner considers this to be routing information. (See Figures 5-7)
- iv. To receive confirmation of the booking request from at least one of the carriers, from the server (See Figure 4B, Steps 14-17 and 26-28).
- v. With respect to the claim limitation of “where in a rate has been agreed upon prior to the transmission of the electronic booking request”: Borgeson discloses the bid request is sent out, the carriers then place a bid, and the bids are presented to the customer. This is the carrier agreeing on the rate. The bids are sent to the customer then the customer choose the carrier, and sends a request for a particular carrier to the shipping coordinator, which then forwards a message onto the carrier for confirmation (see Figure 4B). Therefore the request for the selection of the carrier is considered to be a form of a booking request and the price is agreed upon prior to the booking request sent. It should be noted that this is a system claim, where the system is enabled to perform functions. The function of the price being agreed upon is not being done by the server, it is done outside of the system, therefore the server itself is not effected by this limitation and the limitation is not related to any structure of functionality in the server itself, therefore the examiner considers Borgeson to anticipate this claim limitation. Furthermore it should be noted that the claim does not state who the price is agreed upon with. It could be the carrier has a set rating system, which is agreed upon by the booking system to publish the rates.

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4. With respect to Claim 5: Borgeson discloses in Step 3 and 5, that the customer enters basic shipment data as well as detailed shipment data. The type of information that is in the shipment data is considered to be non-functional descriptive data. A system claim is in essence an apparatus claim, and is limited to the structural limitations of the system, therefore due to the fact that what type of information is entered for the shipment data, the system remains unchanged, and functions the same way, therefore Borgeson anticipates claim 5.

5. With respect to Claim 8: Borgeson discloses a user. However, whether the user is a new customer or an old customer is deemed to be nonfunctional descriptive material and is not functionally involved in the system recited. The system configured to send booking reuests would be the same and perform the same functions whether the user is a new customer of the first entity or an old customer. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

6. With respect to Claim 14: See Step 31.

7. With respect to Claims 15 and 16: See Figures 4B and 7, with corresponding detailed description.

8. With respect to Claims 52, 53, 73 and 74: See figures 5-9 with corresponding detailed description. The requests include origin and destination information, therefore the examiner considers this to be routing information.

9. With respect to Claims 54 and 82: Borgeson discloses the booking request includes basic information, as well as detailed information, the examiner considers this to be shipping

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instructions, due to the fact that the user can input when needed by, therefore the examiner considers this to be shipping instructions.

10. With respect to Claims 55-57: the system of Borgeson discloses a user interface, which allows a user to send messages back and forth with the ship owner. However, the specific type of information in the request or bid, is deemed to be nonfunctional descriptive material and is not functionally related to the system itself. The system of Borgeson is fully capable of sending these types of messages.

11. With respect to Claims 61, 63 and 65: See Figures 4A and 4B.

12. With respect to Claims 58, 60 and 71: See Figure 2 with corresponding detailed description.

13. With respect to Claim 75: Borgeson discloses the user and the carrier entering into a contract, and does not specifically disclose the request comprising a carrier booking number. However, the specific type of information that is contained in the request, such as the carrier booking number, is deemed to be nonfunctional descriptive material and is not functionally involved in the system or the steps recited. The system being capable of sending a booking request would be performed the same regardless of what type of information is on the request. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

14. With respect to Claim 76: See Step 31, and Figure 9.

15. With respect to Claim 77: Borgeson discloses the use of a system that is configured to store and keep track of bids (booking requests). The system of Borgeson allows a user to modify

bids, therefore it is the examiner's position that the system of Borgeson is fully capable of allowing a user to modify a booking request after a container has been moved.

16. With respect to Claims 78-81: See Steps 7-9.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 59, 62, 64, 66, 67, 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeson.

19. As disclosed above for Claims 1 and 68, Borgeson discloses the use of electronic communication, but does not disclose expressly that the information is in EDI format, or by the use of a pop-up dialogue box. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the booking request of Borgeson be in the form of an EDI or pop-up dialogue because Applicant has not disclosed the having the communication be either EDI or a pop-up dialogue box, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any form of electronic communication because it results in a message (booking request) being sent over a network. Therefore it would have been an obvious matter of design choice to modify Borgeson to obtain the invention as specified in Claims 59, 62, 64, 66, 67, 70 and 72.

20. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgeson in view of Altendahl et al. (6,970,825).

21. With respect to Claim 2: Borgeson discloses the use of a booking request, however fails to disclose the use of the booking request being a template that was created by a user. Altendahl discloses the use of a planning engine for a parcel shipping system where requests are made using a template, and the template is created using a template builder (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Borgeson, to have the bid request use a template, as disclosed by Altendahl, in order to have all request be uniform to make planning easier. (See Altendahl Column 2)

22. With respect to Claims 3 and 4: Borgeson and Altendahl disclose the use of templated for requests but do not specifically disclose the template is based on a previous booking or a previous confirmed booking. However, the specific type of information the template is based on is deemed to be nonfunctional descriptive material and is not functionally involved in the system. A system is limited to the structural limitations and functionalities of the structure, therefore the information a template is based on does not affect the function of the Borgeson and Altendahl system. The system using templates for booking request would be function the same way regardless of what type of information the templates are based on. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Response to Arguments

23. Applicant's arguments filed 12/3/07 have been fully considered but they are not persuasive.

24. With respect to Applicant's argument that Borgeson does not disclose "wherein a rate has been agreed upon prior to the transmission of the electronic booking request": As stated above in the rejection. This agreement has been done outside of the system and outside of the server. Therefore due to the fact that the claims are directed to a system, which are held to structural limitations, the rate has not been agreed upon using any of components of the system, it is being agreed upon outside of the server, and outside of the system, therefore does not functionally change the structure of the system as claimed. Furthermore the claims do not recite who the rates are agreed upon with, therefore does not positively recite any of the entities agreeing on the rate, therefore can still be done outside of the system.

25. The applicant's are arguing all other rejections based on Borgeson not disclosing the rate being agreed upon prior to the submission of the booking request. The examiner above, considers this limitation to be not functionally related to the structure of the system, and therefore arguments are not considered to be persuasive and rejection stands as stated above.

Conclusion

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jp

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629